

Remarks:

Claims 1-9 are pending in this application. Applicant has amended claims 2 and 8 and presented new claim 9 to clarify the present invention. Applicant respectfully requests favorable reconsideration of this application.

Applicant has amended the abstract to reduce its length to within the required limit. Accordingly, Applicant respectfully requests withdrawal of the objection to the abstract.

The Examiner rejected claims 2 and 8 under 35 U.S.C. § 112, second paragraph, as indefinite. Applicant has amended claim 2 to reinsert the letters "s" and "w". Applicant has amended claim 8 to recite that the bobbin basket is made of plastic. Applicants have also added new claim 9, which depends from method claim 8 and recites that the bobbin basket is made of plastic. In view of the above, Applicant submits that claims 2 and 8 comply with 35 U.S.C. § 112, second paragraph, and respectfully request withdrawal of this rejection.

The Examiner rejected claims 1, 2, 4, and 7 under 35 U.S.C. § 102(b) as being anticipated by U.S. patent 4,009,670 to Mitchell. The Examiner rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Mitchell in view of U.S. patent 4,858,543 to Badillo.

Mitchell does not disclose the present invention as recited in claims 1 or 7 since, among other things, Mitchell does not disclose a device that includes a gripper hook having a side wall that is wide enough to protect a bobbin basket from being struck by a needle when the needle is

out of normal alignment. As shown in Fig. 3 of Mitchell, the bobbin basket extends well to the right of the gripper hook 15, leaving the bobbin basket unprotected from above. As a result, if the needle were out of alignment to the right (with reference to the view shown in Fig. 3 of Mitchell), the needle would strike the bobbin basket and the gripper hook would be unable to protect the bobbin basket. Therefore, Mitchell does not disclose the present invention as recited in claims 1 and 7. It follows that Mitchell does not disclose the present invention as recited in claims 2 and 4, which depend from claim 1.

In view of the above, Mitchell does not disclose all elements of the present invention as recited in claims 1, 2, 4, and 7. Since Mitchell does not disclose all elements of the present invention as recited in claims 1, 2, 4, and 7, the present invention, as recited in claims 1, 2, 4 and 7, is not properly rejected under 35 U.S.C. § 102(b). For an anticipation rejection under 35 U.S.C. § 102(b) no difference may exist between the claimed invention and the reference disclosure. *See Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q. 841 (C.A.F.C. 1984).

Along these lines, anticipation requires the disclosure, in a cited reference, of each and every recitation, as set forth in the claims. *See Hodosh v. Block Drug Co.*, 229 U.S.P.Q. 182 (Fed. Cir. 1986); *Titanium Metals Corp. v. Banner*, 227 U.S.P.Q. 773 (Fed. Cir. 1985); *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986); and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 U.S.P.Q.2d 1081 (Fed. Cir. 1986).

The combination of Mitchell and Badillo does not suggest the present invention as recited

in claim 8 since, among other things, the combination does not suggest a device that includes a gripper hook having a side wall that is wide enough to protect a bobbin basket from being struck by a needle when the needle is out of normal alignment. Mitchell suggests a structure in which the bobbin basket extends well to the right of the gripper hook 15, leaving the bobbin basket unprotected from above. As a result, Mitchell does not suggest a structure that would protect the bobbin basket if the needle were out of alignment toward the right as shown in Fig. 3 of Mitchell.

Combining Mitchell with Badillo to include a plastic bobbin basket would not suggest the present invention since, as discussed above, Mitchell does not suggest a structure that includes a gripper hook having a side wall that is wide enough to protect a bobbin basket from being struck by a needle when the needle is out of normal alignment. If the structure suggested by Mitchell were provided with a plastic bobbin basket, the bobbin basket could be struck by a bent needle. Thus, a plastic bobbin basket would in this case still need the enforcement shield as provided by the prior art bobbin basket according to Badillo. Therefore, the combination of Mitchell and Badillo does not suggest the present invention as recited in claim 8.

In view of the above, the references relied upon in the office action, whether considered alone or in combination, do not disclose or suggest patentable features of the present invention. Therefore, the references relied upon in the office action, whether considered alone or in combination, do not anticipate the present invention or make the present invention obvious. Accordingly, Applicant respectfully requests withdrawal of the rejection based upon the cited references.

In conclusion, Applicant respectfully requests favorable reconsideration of this case and early issuance of the Notice of Allowance.

If an interview would advance the prosecution of this application, Applicant respectfully urges the Examiner to contact the undersigned at the telephone number listed below.

The undersigned authorizes the Commissioner to charge fee insufficiency and credit overpayment associated with this communication to Deposit Account 22-0261.

Respectfully submitted,

Date: 5/23/05

A handwritten signature in cursive script, appearing to read "Eric J. Franklin", written over a horizontal line.

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